

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-16 were in the application, claim 1 has been amended; claim 5 has been cancelled, and claims 14-16 have been withdrawn.

Entry of this amendment is respectfully requested as reducing the issues for appeal, and/or for placing the claims in condition for allowance. By the amendment, the limitations of claim 5 have been included in claim 1, putting claim 5 in independent form. This renders moot three rejections. The rejection of claims 1, 2, 8 and 11 as being anticipated by Denter is rendered moot in view of the above amendment. The rejection of claims 1-4, 7-10, 12 and 13 as being obvious over Zeder et al in view of Denter is also rendered moot by the amendment. The rejection of Claim 6 as being obvious over the combination of Zeder and Denter as applied to claims 1-4, 7-10, 12 and 13 and further in view of Doyel, U.S. Patent no. 4,212,431 is believed to be rendered moot, as claim 6 now depends from amended claim 1 which includes the limitations of claim 5 therein.

As claim 5 was of record, was searched and rejected, no new search or new issues are raised by the amendment, and entry is proper to reduce the issues on appeal to a single issue, and possibly to put the claims in condition for allowance

Claim 5 was rejected as being obvious over the combination of Zeder and Denter and further in view of Ranta, U.S. Patent no. 6,019,050.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Sys. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

To establish a prima facie case of obviousness based on a combination of references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2d

1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Zeder discloses a food slicer with smooth sidewalls. No recesses or gripping surface is taught or suggested in Zeder.

While Denter shows a scalloped edge, this appears to be only used as a gripping surface and not one which would securely receive the rim, for example, of a bowl. Specifically, the indentations lack the depth necessary for securely mounting a food processing device over a bowl for receiving the sliced product during processing. Rather these appear as curved indents from which a rim could easily slide out during processing.

Denter does not discuss the indented edging, and these appear to be either finger gripping surfaces or means for gripping a flat surface, such as when the device is placed on a table.

While the examiner does not consider the depth to be significant, this is a device that is used to cut various products, with exceptionally sharp blades and surfaces, and having a sufficient depth for securing the device when in use on a bowl is critical to safe operation. A plurality of vertical recesses having sufficient depth for mounting securely on a food utensil, as shown for example in Figs.5a and 5b, must be present. The indented edging of Denter, not discussed as having any purpose, certainly cannot teach or suggest the present invention, particularly where legs that can be used to support the device additionally form, when folded, sidewalls with the recesses therein for mounting on a receiving container.

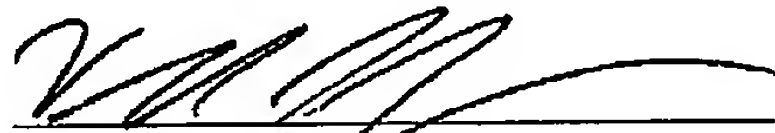
The inclusion of Ranta as teaching a lower leg does not overcome these deficiencies, and amended claim 1, with the limitations of claim 5 therein, is not obvious over the proposed combination.

There is no teaching of suggestion in the combination for incorporating recesses in extending legs, as shown for example in Fig. 7a, and claim 1 as amended, is clearly patentable

over the combination.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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